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**FAX**

#45

**Date:** February 27, 2003  
**To:** Examiner Joseph T. Voitach  
**From:** Ronald I. Eisensetin  
**Message:** Applicants: Marasco et al.

**Pages (including cover): 5**

**Fax: 1.703.305-3014**

**Ph: 1.703.305-3732**

Appln. No.: 08/822,033

Filed: March 24, 1997

**FAX RECEIVED**  
**OFFICIAL** FEB 28 2003  
**GROUP 1600**

For: NUCLEIC ACID DELIVERY SYSTEM, METHODS OF SYNTHESIS AND USE THEREOF

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this Request for Withdrawal of Finality is being transmitted via facsimile to the Office of Finance at the Patent and Trademark office on the date shown below.

Melissa Kruggel  
Melissa Kruggel

2/27/03  
Date: February 27, 2003

**Date:** February 27, 2003  
**To:** Examiner Joseph T. Voitach  
**From:** Ronald I. Eisenstein

**Pages (including cover): 5**

**Fax: 1.703.305-3014**

**Ph: 1.703.305.3732**

**Client/Matter:** 700157-043471

**User No.:**

**Disbursement Amount: \$**

Practitioner's Docket N . 43471-RCE2

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Marasco et al.

Application No.: 08/822,033

Group No.: 1632

Filed: 03/24/1997

Examiner: Woitach, Joseph T.

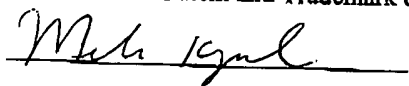
For: NUCLEIC ACID DELIVERY SYSTEM, METHODS OF SYNTHESIS AND  
USE THEREOFCommissioner for Patents and Trademarks  
Washington, D.C. 20231REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION, OR IN THE  
ALTERNATIVE CONDITIONAL PETITION FOR WITHDRAWAL OF FINALITY

Applicants respectfully submit that the finality of the Office Action dated February 11, 2003 was improper and should be withdrawn, for the following reasons:

1. On May 28, 2002, a Final Office Action was mailed in the parent application (serial number 08/822,033, filed March 24, 1997).
2. On October 28, 2002, applicants filed an Amendment after Final Rejection Under 37 C.F.R. 111.6, and Petition or Extension of Time.
3. On November 18, 2002, an Advisory Action (paper no. 40) was mailed, indicating that the proposed Amendment would not be entered because it raised new issues that would further consideration and/or search [copy attached hereto].
4. Accordingly, on November 26, 2002, applicants filed an RCE application, including the previously submitted Amendment and the requisite fee.

CERTIFICATE OF FACSIMILE TRANSMISSION

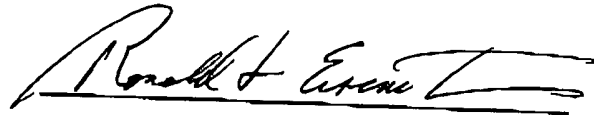
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Melissa Kruggel

Date: February 27, 2003

5. On February 11, 2003 in response to the filing the RCE, a Final Office Action was mailed, indicating that the application was eligible for continued examination under 37 C.F.R. 1.114, and that the proper fee had been paid. The Examiner entered the Amendment filed November 26, 2002, but made the Office Action "final".
6. MPEP 706.07(h), Section VIII, sets forth the conditions required for issuing a First Action Final After Filing an RCE, stating in relevant part: "The action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 *may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met.*" [emphasis added]
7. MPEP § 706.07(b) explicitly states "it would not be proper to make final a first Office action in a continuing or substitute application where that material which was presented in the earlier application after final rejection ... *was denied entry because (A) new issues were raised that required further consideration and/or search...*" [emphasis added]
8. That is precisely the situation that has occurred here.
9. Accordingly, applicants respectfully submit that the finality of the Office Action dated February 11, 2003, was not proper, and respectfully request its withdrawal.
10. In the event that the Examiner does not grant this request to withdraw the finality of the Office Action, please consider this a Petition Under 37 CFR 1.181 to the Commissioner to withdraw finality due to prematurity of final rejection, MPEP § 706.07(c). (See MPEP § 1002(02)(c)(3)(a).) The Commissioner is authorized to charge any fee due in connection with this petition to Deposit Account No. 50-0850.
11. Applicants believe no fee is due. However, please charge any required to Deposit Account No. 50-0850.



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# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/822,033	03/24/1997	WAYNE A. MARASCO	43471-SWC PCE	5884

7590 11/18/2002  
Ronald I. Eisenstein  
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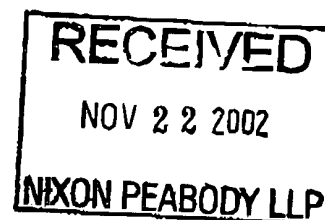
EXAMINER

WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
1632	

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



**Advisory Action**

Application No.

08/822,033

Applicant(s)

Marasco et al.

Examiner

Joseph T. Woitech

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Nov 4, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**THE PERIOD FOR REPLY [check only a) or b)]**

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_ Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: The proposed means limitations requires a new search and further consideration.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ Th a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
Applicants' arguments are directed to claim amendments which have not been entered.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1 and 3-16

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

*Deborah Crouch*  
DEBORAH CROUCH  
PRIMARY EXAMINER  
GROUP 1800

Advisory Action

Part of Paper No. 40